



TRADEMARK  
Docket No. 110.2\*1/GJN/P622

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

WALTERS GARDENS, INC.

Opposer,

v.

PRIDE OF PLACE PLANTS, INC.

Applicant.

Opposition No. 91153755

MARK: PIILU  
SERIAL NO.: 76,201,447  
FILED: JANUARY 29, 2001

**APPLICANT'S BRIEF**



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3 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 20:3, at 20-9  
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**I. INTRODUCTION**

Since at least 1998, Applicant Pride of Place Plants, Inc. ("PoPP") has used "PIILU" as a trademark identifying PoPP as the source of a Clematis plant that has the current cultivar name "Little Duckling" (and the earlier cultivar name "Kivso"). Yet now Opposer Walters Gardens, Inc. ("WGI") is attempting to hijack PoPP's PIILU trademark by demanding that the Board strip away PoPP's well-established trademark rights, allowing WGI (and others) to trade on the good will that PoPP has created in its mark. WGI relies mostly on dubious or inadmissible evidence. However, WGI cannot deny that any occasional attempts by others to use "PIILU" as the generic term for Clematis Little Duckling in the United States occurred *after* PoPP had established its trademark rights -- and that PoPP has consistently policed and enforced its trademark rights against such third parties when inadvertent use was detected.

WGI has presented no credible evidence whatsoever supporting its claim that PIILU is a cultivar name, or otherwise generic. In sum, WGI has fallen far short of its burden of proving that PoPP is not entitled to register the trademark that it has been using for years. Therefore, the Board should reject WGI's Opposition and allow registration of the PIILU mark.

**II. WGI BEARS THE BURDEN OF PROVING THAT POPP IS NOT ENTITLED TO REGISTER PIILU**

In its brief, WGI offers a number of facts, some real and others, as explained below, imagined; and mentions a few legal doctrines. However, WGI does not and cannot tell a coherent story about why PoPP should not be entitled to register the mark it has been using since 1998. Interestingly, WGI does not even acknowledge its burden of proof in this proceeding. It is well established that in an opposition proceeding, the challenging party bears the burden of proving its case by a preponderance of the evidence. *Eastman Kodak Co. v. Bell & Howell*

*Document Mgmt. Prods. Co.*, 994 F.2d 1569, 1575, 26 U.S.P.Q. 2d 1912 (Fed. Cir. 1993). See also, 3 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 20:3, at 20-9 (4th ed. 2005) ("In an opposition proceeding, the opposer, as the party in the position of a plaintiff, has the burden of proof to establish that applicant does not have the right to register its mark").

The Board should bear in mind WGI's burden of proof, particularly since, as explained in detail below, WGI has either invented or mischaracterized much of the "evidence" it characterizes as most important. And a great deal of that evidence is not admissible. PoPP, on the other hand, has submitted substantial, credible, admissible evidence that more than supports its right to obtain a registration for its PIILU mark.

### **III. WGI HAS FAILED TO ESTABLISH BY A PREPONDERANCE OF THE EVIDENCE THAT "PIILU" IS A CULTIVAR NAME**

#### **A. Naming Conventions And Cultivars**

A cultivar or variety name is a name given to "cultivated varieties or subspecies of live plants or agricultural seeds." A cultivar may be given an arbitrary name, and this name serves as the generic name of the plant. TMEP § 1202.12. According to standard naming conventions for plants, the genus is listed first, followed by the cultivar name. Thus, the particular plant that WGI refers to in its brief, *Clematis Little Duckling*, bears the genus name *Clematis* and the cultivar name *Little Duckling*. [Sorenson Depo., at 2:10-19.]

There is no established method for assigning a plant a cultivar name. Courts typically find that the cultivar name, as a generic designation, is the name that purchasers encounter "in the marketplace where such products are sold." *In re Hilltop Orchards & Nurseries, Inc.*, 206 U.S.P.Q. 1034, 1035 (TTAB 1979). A purchaser must have "some common descriptive name he can use to indicate that he wants one particular variety of apple tree, rose, or whatever, as

opposed to another, and it is the varietal name of the strain which naturally and commonly serves this purpose." *Id.* at 1036.

In this case, distinguishing between a cultivar name and a trademark is critical because, as WGI points out, a cultivar name cannot serve as a trademark. *See, e.g.*, T.M.E.P. § 1202.12. Therefore, WGI's entire Opposition hinges on its argument that PIILU is a cultivar name instead of a trademark. However, that is simply not the case. The truth is that ***PIILU is not a cultivar name, and instead has been used for the last seven years as a trademark.*** Therefore, the entire premise of WGI's Opposition fails.

**B. PIILU Is A Trademark And Not A Cultivar Name**

As PoPP testified repeatedly at its testimonial deposition, since at least 1999 it has used "PIILU" as a trademark, and has used the "TM" symbol when referring to PIILU. [See Deposition of Rick Sorenson ("Sorenson Depo."), at 3:14-4:21; 5:15-21; 7:20-24; 9:6-10:4; 10:24-11:11; 12:1-15; 13:1-17; 14:19-15:2; 15:6-12; 15:16-22; 16:19-17:2; 17:21-18:2; 18:6-14; 19:1-12; 19:20-20:8; 21:16-23; 24:3-25:1 and Exhibits 1-13.] WGI is unable to rebut the fact that PoPP has clearly signaled to the purchasing public that PIILU is a trademark, and not a cultivar name.

Apparently not convinced of the merits of its case, WGI resorts to making a patently false statement to the Board, claiming that PoPP has been unable to "provide a common or generic name for the cultivar sold in connection with" the PIILU trademark. [Opposer's Brief, p. 13.] In fact, as WGI knows, PoPP has identified *two* such names, testifying at deposition that the original cultivar name was Kivso, and that this name later was changed to Little Duckling. [Sorenson Depo. at 2:17-22; 3:10-17; 15:13-17.] WGI not only concealed that fact from the

Board, but it actively and intentionally misstated the record in its brief.<sup>1</sup> Such overt misstatements must cast a doubtful shadow over all of WGI's other arguments.

Although WGI keeps repeating that PIILU is supposedly a cultivar name, it never discusses what type of proof is required to make that showing. In the primary reported decision on which WGI relies in its brief, the applicant *conceded* that it was attempting to trademark a cultivar name. See *Dixie Rose Nursery v. Coe*, 131 F.2d 446, 55 U.S.P.Q. 315 (D.C. Cir. 1942). See also, *In re Farmer Seed & Nursery Co.*, 137 U.S.P.Q. 231 (TTAB 1963) (registration refused where applicant conceded that its trademark was the same as the varietal name of a plant). WGI does not cite any legal standards for determining in a disputed case like this one whether a name is a cultivar. Instead, WGI relies on the general principle that if "the public" associates a name with a specific variety of plant, then that name is the cultivar. [See Opposer's Brief, p. 6.] WGI never explains what the relevant "public" is, or what type and quantity of evidence is required or sufficient to establish what the "public" perceives. Instead, WGI does nothing more than offer some inadmissible deposition testimony and a few pages from books that have not been shown to have any significance in a vain attempt to support its case. Significantly, WGI ignores the requirement of examining the way a cultivar or mark is used *in the marketplace*, and does not

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<sup>1</sup> WGI apparently bases its half-truth on a response to a poorly-written and compound interrogatory that requested that PoPP identify in a single response "the genus, species, subspecies, varietal, cultivar, common, and commercial names, if any, for the cultivar of Clematis sold and promoted in association with the PIILU mark." [See WGI's Exhibit 8, at p. 7.] PoPP objected to this nearly incomprehensible interrogatory (which appears to ask for, among other things, a "genus name" for a cultivar, which makes no sense). Not surprisingly, PoPP responded that it could not answer the interrogatory because of its nonsensical grammatical construction. PoPP went on to affirm that "PIILU is not the name of a Clematis cultivar used in the United States." [Id.] When PoPP was asked the more direct question of what the cultivar name is for the particular plant at issue, PoPP had no trouble answering that there have been two cultivar names: Kivso and, later, Little Duckling. [See Sorenson Depo., at 2:17-22; 3:10-17; 151:13-17.]



offer any evidence or argument on that issue.

As explained above, PoPP advertises and promotes PIILU in the marketplace as a trademark, and uses Little Duckling (formerly, Kivso) as the cultivar name. For example:

- A price list created in approximately October 1998 and distributed to PoPP's customers clearly designates that PIILU is a trademark. [Sorenson Depo., at 5:24-6:8 and Exhibit 1.]
- A series of PoPP testing and growers' agreements entered into with plant growers and purchasers over a period of several years consistently use the <sup>TM</sup> symbol when referring to PIILU. [Sorenson Depo., at 6:12-19:12 and Exhibits 2-12.]
- The growers' agreements specifically required the purchasers to use the trademark designation when re-selling plants under the PIILU mark. The parties to those agreements never objected to this requirement, or to PoPP's designation of PIILU as a trademark. [Sorenson Depo. at, e.g., 9:14-10:4, Exhibits 2-12.]
- PoPP uses a trademark symbol next to the name PIILU on its plant labels. [Sorenson Depo., at 19:15-20:20, and Exhibit 13 at page POP007.]
- As of 2003, PoPP's web site contained an express reference to Kivso (later changed to Little Duckling) as a cultivar name and PIILU as a trademark. [Sorenson Depo., at 20:21-22:20 and Exhibit 13 at pages POP008-POP013, POP019.]

The consistent use of PIILU as a mark by PoPP, the company with the exclusive license to propagate and sell PIILU in North America,<sup>2</sup> is compelling evidence of how that mark is

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<sup>2</sup> See, e.g., Exhibit 2.

perceived in the marketplace. Purchasers and prospective purchasers encounter Little Duckling, and not PIILU, as a cultivar; and PIILU as a trademark. WGI has not offered, and cannot offer, evidence to the contrary. Instead, WGI relies, as explained below, on references in obscure publications, and on inadmissible third party testimony. That simply is not enough.

**C. WGI Has Failed To Submit Admissible, Credible Evidence Sufficient To Meet Its Burden Of Proving That The Trademark PIILU Is Encountered In The Marketplace As A Cultivar Name**

**1. WGI Mischaracterizes And Exaggerates The "Evidence" On Which It Relies**

Although PoPP does not bear the burden of proving that PIILU is not a cultivar name, PoPP's evidence discussed above overwhelmingly establishes that PIILU is a trademark. All WGI can do to counter this evidence is point to a few documents in which certain individuals may or may not use a trademark symbol when referring to PIILU. One of those documents is an excerpt from an "Encyclopedia of Clematis" that purports to refer to PIILU as a cultivar. [Opposer's Exhibit 6.] WGI argues that this is a "valuable" book written by "scholars and experts in the field of the genus *Clematis*." [Opposer's Brief, p. 9.] However, there is no foundation for WGI's claims. To the contrary, during PoPP's testimonial deposition, PoPP testified, and WGI apparently agreed, that the "expertise" of one of the book's authors -- Everett Leeds -- apparently consists of having "a very nice garden" and taking "a fancy in horticulture." [Sorenson Depo., at 118:9-22.] WGI clearly is stretching the definitions of "scholarship" and "expertise." Moreover, WGI does not present any evidence at all that this "encyclopedia" is widely distributed or read, in the United States or anywhere else, or is relied on by anyone as a definitive source of cultivar names. And WGI fails to disclose to the Board that PoPP, as part of

its ongoing policing of its trademark rights, requested that the next edition of the book be corrected to include the correct cultivar name. [Sorenson Depo., at 161:12-162:3.] Again, WGI has, at best, exaggerated, and failed to disclose important details in the record.

WGI claims that the "most telling" evidence that PIILU is a cultivar is an article written by PoPP's owner, Rick Sorenson. WGI claims that in this article (attached to Opposer's Brief as Exhibit 3), Mr. Sorenson "specifically mentions Clematis 'PIILU' as a variety of climbing *Clematis*." [Opposer's Brief, p. 8 (italics and underlining original).] This is simply not true. Although the article does mention PIILU, the article never mentions, "specifically" or otherwise, that PIILU is a variety. What is "most telling" is that WGI chose to make the centerpiece of its evidentiary argument an "admission" that does not exist. Again, WGI should not be rewarded for its repeated efforts to deceive the Board by exaggerating or misstating the record.<sup>3</sup>

**2. Most Of WGI's "Evidence" Is Inadmissible And Should Be Disregarded**

WGI purports to rely on certain evidence that it suggests indicates some members of the public may have a mistaken belief as to the correct cultivar name (or perhaps, like WGI, are attempting to hijack PoPP's trademark). Much of that evidence is inadmissible. For instance, WGI cites to the deposition transcripts of Brewster Rogerson, Maurice Horn, and Christopher Hansen. WGI never conducted discovery depositions or written discovery for any of these individuals. WGI also failed to identify these individuals during the discovery period in

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<sup>3</sup> WGI cannot back away from its misrepresentation by arguing that because the article discusses different cultivars, WGI meant to suggest that it had merely inferred that PIILU was a cultivar. Even if the article could be seen as implying that PIILU was anything other than a trademark, that would be a far cry from "specifically mentioning" that PIILU is a cultivar or variety. In fact, what was "specifically mentioned" in the article is PIILU's status as a trademark: on page 42 of WGI's Exhibit 3, the word "Piilu" appears with a <sup>TM</sup> symbol.

response to PoPP's discovery requests, which included PoPP's Interrogatory No. 3, requesting identification of "person(s) most knowledgeable about alleged third party use of the term PIILU for live plants," and Interrogatory No. 16, requesting identification of witnesses from whom WGI intended to present testimony.

Instead, WGI waited until its testimony period to identify these three witnesses for the first time, by serving supplemental interrogatory responses on August 3, 2004, identifying all three individuals in response to PoPP's Interrogatories Nos. 3 and 16. The next day, WGI served a notice to take the testimony deposition of Maurice Horn, and served similar notices for the other two individuals shortly thereafter. In response to the notices of deposition, PoPP promptly served objections noting the inappropriateness of the depositions, and the prejudice that would be caused to PoPP. PoPP restates its objections to the admissibility of this evidence.

The testimonial depositions of Mr. Hansen, Mr. Horn, and Mr. Brewster, including any documents they authenticated, should be excluded. WGI's failure to fully and fairly participate in the discovery process cannot be rewarded by allowing last minute witnesses to be introduced without an opportunity for PoPP to engage in discovery. WGI's actions deprived PoPP of the opportunity to conduct discovery depositions for each of the three individuals, and to serve requests for production of documents on them. The prejudice caused by WGI could have been avoided if WGI had sought to re-open discovery, which would have provided equal opportunities to both parties. Instead, WGI decided not to play fair and, as a result, the resulting testimony and documents should be excluded.

In determining whether to preclude the late introduction of evidence, courts focus on "surprise and prejudice, including the opponent's ability to palliate the ill effects stemming from

the late disclosure." *Thibeault v. Square D Company*, 960 F.2d 239, 246 (1st Cir. 1992) (citation omitted). Thus, expert testimony offered shortly before trial properly was excluded. *Id.* at 247-248. Similarly, the Federal Rules expressly provide that information that should have been disclosed through discovery may be precluded from use as evidence at trial. Fed.R.Civ.P. 37(c)(1). PoPP submits that these same principles should control here. WGI bears the burden of proving how the "public" perceives PoPP's use of the PIILU mark, yet withheld any alleged evidence of such perception (or did not even seek out such evidence) until its testimony period had begun. This is the equivalent of springing "surprise witnesses" during a courtroom trial, and should not be permitted. Thus, consistent with case law, the Federal Rules, and the Board's inherent authority under *TBMP* § 527.01(e), the untimely testimony of Hansen, Horn, and Brewster, including the documents they attempted to authenticate, should be excluded.

Additionally, WGI makes much of an "International Clematis Registry" (pages of which WGI submits as Opposer's Exhibit 6). That "registry" contains a few cryptic references under the heading "'Piilu,'" including the remarks "R: U. & A. Kivistik (1984)," and "REG: EPPIVCD (2000)." From this WGI extrapolates that the record "tends to give credit to the plant breeder" for registering PIILU as a Clematis, and that this "registry" somehow proves that PIILU therefore is a cultivar. [Opposer's Brief, pp. 7-9.] There is no foundation for WGI's interpretation of the purported "registry" -- and any statements within that registry obviously are inadmissible hearsay. Fed.R.Evid. 801(c), 802. Moreover, there is no evidence that this "registry," which is published by the Royal Horticultural Society, is read by more than these few people in the United States; and the entries are made "voluntarily" and without any independent verification by the authors as to their accuracy. [Sorenson Depo., at 78:1-79:18.] Thus, WGI

has hardly established that this publication is relied on by anyone researching cultivar names (or anything else). Again, for purposes of establishing the cultivar name recognized by purchasers in the marketplace, this "registry" is worthless.

**3. PoPP Established Its Trademark Rights In PIILU Before The Alleged Third Party Uses WGI Identifies**

Even if WGI's evidence was admissible -- and it is not -- in most cases WGI relies on "evidence" that came into existence *after* PoPP had established its trademark rights in PIILU (*i.e.*, after 1998). *See, e.g.*, WGI's Exhibits 4-7, 9. WGI argues that it is significant that these alleged uses occurred before PoPP filed its trademark application, but the issue is priority of use, not the date on which the application was filed. *See Sengoku Works v. RMC Int'l*, 96 F.3d 1217, 1219 40 U.S. P.Q. 2d 1149 (9th Cir. 1996) ("To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services."). Thus, this "evidence" does nothing to establish the cultivar name in existence as of the date on which PoPP gained its trademark rights (and as explained in Section V below, it also is not sufficient to find that PoPP's established mark has since become generic).

WGI has failed to show that notwithstanding the promotion of Kivso/Little Duckling as cultivars and PIILU as a trademark, more than a few members of "the public" may mistakenly believe that PIILU is generic. This cannot be sufficient for WGI to bear its burden of proof, particularly since there is no question that PoPP has expended a great deal of energy and money over the last several years establishing and policing its trademark rights in the name "PIILU," and that PIILU is clearly communicated to the relevant "public" as a trademark and not a cultivar.

**4. Policy Considerations Favor Registration**

Finally, it is important to bear in mind the policy behind disallowing registration of cultivar names as trademarks. The purpose of that rule is to permit buyers who are "indifferent to source" to name a particular type of goods without having to use a trademark to do so. *See, e.g., Dixie Rose*, 131 F.2d at 447. Here, a purchaser could buy a Clematis cultivar under the cultivar name Little Duckling without having to use the trademark, or could use the name PIILU if describing a Little Duckling plant from a particular source -- PoPP. Source identification is a hallmark of trademark law, and WGI is seeking to prevent PoPP from continuing its established use of PIILU as a source identifier. WGI should not be permitted to do so, particularly on the scant record it has introduced and on which it relies.

**IV. THERE IS NO ADMISSIBLE EVIDENCE THAT PIILU IS THE ESTONIAN WORD FOR A CULTIVAR NAME**

Apparently recognizing that it does not have sufficient evidence to prevail, or to bring itself within the scope of *Dixie Rose*, WGI may be misleading the Board again by stating that Applicant has "admitted" that PIILU is a generic cultivar name and that the "preponderance of the evidence" somehow establishes that PIILU is Estonian for the English cultivar name "Little Duckling." [See Applicant's Brief, pp. 5-6.] As WGI knows, these remarks are not correct.

First, it is true that on occasion, PoPP has stated its belief (*e.g.*, in response to an office action, and at deposition), that "Little Duckling" is the equivalent of the Estonian word "PIILU." However, it is also true that PoPP does not have firsthand knowledge if that is the case. WGI makes much of the fact that at deposition, Mr. Sorenson testified that Little Duckling was the equivalent of PIILU. But WGI conceals from the Board that Mr. Sorenson later clarified that he based this belief solely on a conversation with an Estonian plant breeder, and that he himself

does not read, speak, or understand Estonian, and does not know whether Little Duckling would be translated back into Estonian as "Piilu." [Sorenson Depo. at 160:10-161:7.] In fact, Mr. Sorenson could not testify as to whether someone in Estonia would ever translate the cultivar name "Little Duckling" into Estonian when asking for one of PoPP's trademarked plants by name. [Sorenson Depo. at 48:10-15; 161:8-11.] Thus, there is *no evidence by anyone with personal knowledge* -- much less a "preponderance" of evidence -- as to the translation of PIILU into English, or of Little Duckling into Estonian.<sup>4</sup>

The Board also should note that PoPP's original understanding apparently was incorrect. According to a number of online translation web sites, PIILU does not translate into English as Little Duckling, and neither Little Duckling nor duckling translates into PIILU. In fact, there appears to be no English translation for the word "piilu," and the Estonian word for "duckling" is "pardipoeg." *See, e.g.,* English-Estonian Dictionary at [http://www.ibs.ee/dict/translate](http://www.ibs.ee/dict/translate.cgi?word=duckling&language=English).

<http://www.ibe.ee/dict/translate.cgi?word=piilu&>

<sup>4</sup> WGI does not even attempt to explain the supposed significance of the translation issue. In its unsuccessful motion for summary judgment, WGI argued that the doctrine of foreign equivalents prohibited registration of PIILU. However, the cases on which WGI relied explained that the doctrine of foreign equivalents bars registering the foreign name for the item with which the trademark is to be associated -- for example, since "Chupa" is Spanish slang for "lollipop," under the doctrine of foreign equivalents Chupa cannot serve as a trademark for lollipops. *See Enrique Bernat F., S.A. v. Guadalajara, Inc.*, 210 F.3d 439, 445, 54 U.S.P.Q. 2d 1497 (5th Cir. 2000). If WGI could establish that Little Duckling and PIILU do mean the same thing, the doctrine of foreign equivalents would not apply because PoPP is not using PIILU to refer to ducks, specifically baby ducks.

<sup>5</sup> WGI may attempt to argue that this innocent mistake somehow constitutes fraud on the Patent and Trademark Office. Nothing could be further from the truth: PoPP did not make a knowingly false statement, and PoPP's belief that PIILU meant little duckling was not material to whether the mark should be registered. *See Medinol Ltd. v. Neuro Vasx, Inc.*, 67 U.S.P.Q.2d 1205, 1209 (TTAB 2003) ("A trademark applicant commits fraud in procuring a registration when it makes material representations of fact in its declaration which it knows or should know to be false"). *See also, Yocum v. Covington*, 216 U.S.P.Q. 210 (TTAB 1982) (fraud must be "proved to the hilt" with considerable consideration given to honest mistakes and inadvertence).



language=Estonian; <http://www.ibe.ee/dict/translate.cgi?word=duckling&language=English>;  
<http://www.ibe.ee/dict/translate.cgi?word=duck&language=English>. *See also*, English-Estonian  
Online Dictionary at [http://www.lingvosoft.com/main.jsp?do=Lingvosoft.com-online-form\\_](http://www.lingvosoft.com/main.jsp?do=Lingvosoft.com-online-form_sample&direction=2&status=translate&lang1=23&lang2=et&source=piilu)  
[sample&direction=2&status=translate&lang1=23&lang2=et&source=piilu](http://www.lingvosoft.com/main.jsp?do=Lingvosoft.com-online-form_sample&direction=1&status=translate&lang1=23&lang2=et&source=duckling); [http://www.](http://www.lingvosoft.com/main.jsp?do=Lingvosoft.com-online-form_sample&direction=1&status=translate&lang1=23&lang2=et&source=duckling)  
[lingvosoft.com/main.jsp?do=Lingvosoft.com-online-form\\_](http://www.lingvosoft.com/main.jsp?do=Lingvosoft.com-online-form_sample&direction=1&status=translate&lang1=23&lang2=et&source=duckling)  
[sample&direction=1&status=](http://www.lingvosoft.com/main.jsp?do=Lingvosoft.com-online-form_sample&direction=1&status=translate&lang1=23&lang2=et&source=duckling)  
[translate&lang1=23&lang2=et&source=duckling](http://www.lingvosoft.com/main.jsp?do=Lingvosoft.com-online-form_sample&direction=1&status=translate&lang1=23&lang2=et&source=duckling).<sup>6</sup>

Thus, again, WGI's "translation" argument fails utterly.

**V. WGI HAS FAILED TO MEET ITS BURDEN OF PROVING THAT THE  
TRADEMARK PIILU HAS BECOME GENERICIZED**

Although most of WGI's arguments are difficult to follow, WGI appears to argue that alleged third party uses of PIILU that began after PoPP had established its trademark rights somehow have genericized PoPP's mark. [Opposer's Brief, at pp. 6-12.] That is not the case.

To establish that a mark has become generic, a party must demonstrate that the mark is not policed as a trademark and is commonly used to describe a type of product. *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 1569-70, 35 U.S.P.Q. 2d 1554 (Fed. Cir. 1995). WGI has failed to establish either of these elements. Although as noted above, WGI offers limited third party evidence that some people incorrectly use the mark "PIILU," PoPP has explained that it polices its marks and takes affirmative steps to ensure that anyone licensed to sell the Little Duckling plans uses PIILU as a trademark. [See Sorenson Depo. at, *e.g.*, 22:24-2.] In fact, although WGI touts the Encyclopedia of Clematis as a definitive book on Clematis, WGI fails to point out to the Board that, as noted above, PoPP contacted one of the authors of that book and

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<sup>6</sup> Copies of these dictionary definitions are attached to this brief, and PoPP requests that the Board take judicial notice of the definitions under Federal Rule of Evidence 201 and TBMP § 704.12.

insisted that in the next edition, the book be corrected to show PIILU as a trademark and not a cultivar name. [Sorenson Depo., at 161:12-162:3.]

Additionally, WGI cannot show that PIILU has become generic because WGI has produced no credible evidence that consumers would consider PIILU generic. Whether a term is generic depends on the perception of the "purchasing or consuming public," and not the perceptions of manufacturers or vendors. *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 641 19 U.S.P.Q. 2d 1551 (Fed. Cir. 1991). Therefore, the party seeking a finding that a term is generic must produce evidence of consumer understanding. *Id.* In *Magic Wand*, petitioner attempted to support its argument that "touchless" was generic for brush-free car washes by introducing evidence from advertisements and trade articles. The Federal Circuit affirmed the Board's rejection of this argument, noting that there was no evidence of how consumer of car wash services would perceive the term. The court noted that petitioner had "supplied no survey evidence of consumer understanding, no letters or testimony from consumers, and no affidavits from consumers showing generic use or understanding of TOUCHLESS." *Id.* at 641.

Here, WGI relies on specialized publications and the (inadmissible) testimony of three industry "insiders" to argue that the consuming public views PIILU as the generic name of a particular plant. WGI has introduced no survey evidence or any other credible evidence of how a consumer in the marketplace would perceive PIILU. In the absence of any admissible, credible evidence that PIILU's trademark rights have become generic, WGI's arguments fail. The trademark rights in PIILU that PoPP obtained years ago still remain.

**VI. THE TRADEMARK EXAMINATION WAS PROPER**

WGI argues that the Examining Attorney failed to comply with the examination requirements for applications to register marks containing wording for live plants. Specifically, WGI alleges that the Examining Attorney failed to meet the following requirements of *TMEP* § 1202.12 and 37 CFR Section 2.61(b): (1) to inquire whether the proposed mark has been used as a varietal name, and (2) to undertake an independent investigation of evidence that would support a refusal, including using sources that are appropriate for the particular goods, such as a variety name search of plants certified under the Plant Variety Protection Act listed at <http://www.ars-grin.gov/npgs/searchgrin.html>. A review of the file history for the PIILU mark proves that WGI's allegations are simply false.

WGI calls the PIILU application "defective" and claims that the Examining Attorney failed to follow *TMEP* § 1202.12 because: "The only requirement imposed by the Office was to include a translation of PIILU into English." [Opposer's Brief, p. 13.] This statement is a complete misstatement of the office action published in the file history. Specifically, the Examining Attorney fully complied with the requirements of *TMEP* § 1202.12 and 37 CFR Section 2.61(b), as evidenced by the following language in the May 25, 2001 Office action:

**General Inquiry on Significance**

The applicant must indicate whether PIILU has any significance in the relevant trade, any geographical significance or any meaning in a foreign language. 37 CFR Section 2.61(b).

[Office Action, Opposer's Exhibit 1, at p. 10.]

The Examining Attorney's recitation of the relevant CFR section, as well as separate inquiries into whether PIILU has any significance in the relevant trade is obviously tantamount to an inquiry into whether the mark has been used as a varietal name. Thus, the Examining Attorney made the appropriate inquiry to PoPP, and PoPP's subsequent response was complete.

Concerning the Examining Attorney's undertaking of an "independent investigation," WGI once again misstates the record. Specifically, WGI sets forth the *TMEP* requirement for an "independent investigation" using sources such as conducting a variety name search of plants certified under the Plant Variety Protection Act as listed on the appropriate website. WGI then claims that a "review of the file history reveals no such inquiry by the examining attorney." [Opposer's Brief, p. 12.] To the contrary, the file history clearly shows that the Examining Attorney performed three separate searches in that database, including searches of the terms "duckling," "little duckling," and "piilu." [*Id.*, at pp. 16-18.]

Therefore, WGI's allegation that the PIILU application is "defective" because the Examining Attorney failed to comply with the requirements of the *TMEP*, is not only wrong, but is completely contradicted by the record to which WGI cites.

Moreover, there is no authority for WGI's proposition that if the Examining Attorney had made an error, then remand to the Examining Attorney would be an available or appropriate remedy. Remand is authorized when new facts are disclosed during an inter parties proceeding that appear to render a mark not registerable. 37 C.F.R. § 2.131. In this case, the facts relevant to WGI's allegations have always been reflected in the file history. Thus, WGI's argument regarding the examination of the PIILU mark, like its other arguments, is based on a misstatement of the record and a misapplication of the law.

**VII. CONCLUSION**

WGI bears the burden of proving that PoPP is not entitled to register its PIILU trademark. WGI has failed to meet that burden, and in fact has attempted over and over again to misstate the record to the Board in a tacit admission that it has no real evidence or argument supporting its position. There is no question that PIILU is not a cultivar name, that PoPP long ago established trademark rights in PIILU, and that PIILU has not become genericized. If the Board grants PoPP's application, then the public will still be able to purchase Little Duckling cultivars without using PoPP's mark, and will be able to identify the source of particular Little Duckling plants by using the PIILU mark. If the Board denies PoPP's application, then PoPP will no longer be able to identify itself as the source of the Little Duckling cultivar it has sold and promoted for years, and third parties will be able to take advantage of the good will associated with the PIILU mark.

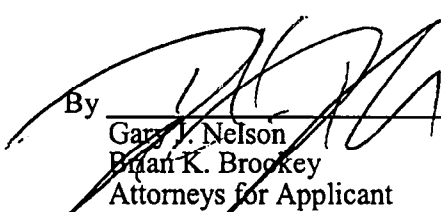
The facts, the law, and fundamental fairness all compel granting the application. Therefore, the Board should reject all of WGI's arguments and permit PoPP to register its mark, PIILU.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

Date: August 15, 2005

By



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# English-Estonian Dictionary

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duckling

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Translations of **duckling** from English:

duckling

*n.* pardipoeg

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piilu

Source language: ☐ English ☒ EstonianTranslations of **piilu** from Estonian:

peep

v. piiluma; välja piiluma{out}; n. piilumine; vargsi heidetud pilk; põgus pilk; **have a peep at** (millelegi) vargsi või põgusat pilku heitma; **at the peep of day** koidikul  
n. piiksatus; v. piiksuma

peer

v. pinevalt silmitsema, lähedalt vaatlama; piiluma  
n. (kellegagi) üheväärne või võrdne isik, omataoline; peer, lord; **without peer** võrratu

pry

v. piiluma, salaja vaatama; omanina toppima{into}  
v. (lahti) kangutama

scout

n. skaut; piilur, luuraja; luurelaev; luurelennuk; v. luurama{about, around}

sneak

v. hiilima; [kõnek.] peale kaebama{on}; [kõnek.] näppama, varastama; **sneak off (või away)** vargsi minema hiilima; **sneak a look** vargsi vaatama, piiluma; n. argpüks; [kõnek.] kaevupunn

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# English-Estonian Dictionary

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duck

Source language: ☒ English ☐ Estonian

Translations of **duck** from English:

duck

*n.* part; pardiliha

*v.* sukeldama; sukelduma; langetama; *n.* sukeldumine; sukeldamine;  
langetamine

duckling

*n.* pardipoeg

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4. Part of speech abbreviations list
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piilu



Translate into Estonian

Translate into

### Results:

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piilumisava  
piilur

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### Results:

#### Estonian

N pardipoeg

### See Also:

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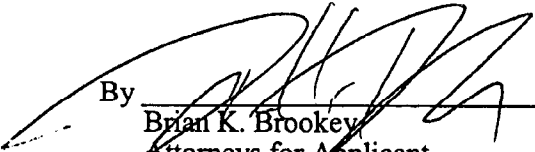
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